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EXAMINER

MUSSER, BARBARA J

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/830,419

Applicant(s)

NAGELE ET AL.

Examiner

Barbara J. Musser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-32 and 34-53 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 25-52 have been renumbered 26-53.

2. Claim 43 is objected to because of the following informalities: the word theroplastic appears in line 5. This is believed to be --thermoplastic--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 25, 27-31, 49, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 25, it is unclear what the scope of the claim is as it is dependent on canceled claims. It appears this claim was intended to be canceled with claims 1-24. It is suggested it be canceled.

Regarding claims 27 and 29-31, it is unclear whether the claims are intended to be open or closed as the independent claims states the carrier consists essentially of

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the material(closed) while these dependent claims indicate the carrier comprises a material(open). The comprising language broadens the claim rather than narrowing it as dependent claims must do.

Regarding claim 28, it is unclear if "contains" is open or closed language.

Regarding claims 27 and 29, it is unclear what is meant by "a natural polymer on the basis of lignin." This is assumed to mean a natural polymer based on lignin.

Regarding claim 49, it is unclear if the several decorative layers of the claim are the plurality of decorative layers of claim 43. It is unclear how different the kinds of material forming the decorative layer must be.

Regarding claim 50, it is unclear whether the fiber layer is between the decorative layer and the carrier or the decorative layer is between the fiber layer and the carrier as claim 43 does not require the placement of the decorative layer in the press prior to placement of the carrier layer but the specification does not indicate the fiber layer can be the outermost layer when a decorative layer is also present.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26, 27, 30-32, 37-49, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartzell(U.S Patent 1,954,754) in view of Rettenbacher et al.(U.S. Patent 5,939,192) and Jaschke et al.(U.S. Patent 4,205,107).

Hartzell discloses forming a composite body by pressing multiple overlapping layers of veneer into a wood substrate and bonding via an adhesive.(Pg. 2, ll. 13-40,65-70) It does not disclose a substrate consisting essentially of natural polymers. Rettenbacher et al. discloses a molding compound made from natural polymers which can replace wood. This material is biodegradable and its strength and other characteristics are independent of the direction of its fibers or growth rings.(Col. 1, ll. 16-18; Col. 2, ll. 49-59) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the material of Rettenbacher et al. as the substrate of Hartzell since it has all the advantages of wood, i.e. biodegradability, and does not have the drawbacks of wood such as characteristics dependent on fiber direction and growth rings(Col. 2, ll. 49-59) particularly since Jaschke et al. discloses it is known to bond wood veneer to thermoplastic substrates.(Col. 1, ll. 4-8) Overlapping is considered to mean that only parts of the two decorative layers lay on top of each other.

Regarding claim 27, Rettenbacher et al. discloses the substrate can be made from lignin.(Col. 3, ll. 17-22)

Regarding claims 30 and 31, Rettenbacher et al. discloses the substrate can contain wood fiber reinforcement.(Col. 3, ll. 31-34)

Regarding claims 37-42, the uses of veneer are well-known in the wood-working arts. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to use the veneer surfaced material of Hartzell and Rettenbacher et al. in any of the well-known products made with veneers since it would look the same but have better properties.

Regarding claims 40 and 42, Jaschke et al. discloses veneer substrates can be used in furniture.(Col. 1, ll. 15-17)

Regarding claim 43, Hartzell discloses the veneer is pressed into the substrate.(Pg. 2, ll. 13-40)

Regarding claim 44, while the reference discloses placing the substrate on the press and the veneer onto the substrate, one in the art would appreciate that pressing the substrate into the veneer is an obvious alternative in the art.

Regarding claims 45 and 46, one in the art would appreciate that the pressure and temperature necessary to press the veneer into the substrate is dependent on the substrate and would choose the appropriate pressure and temperature based on the substrate. Only the expected results would be achieved.

Regarding claim 47, Hartzell discloses the veneer is pressed into the substrate until the layers are flush.(Pg. 2, ll. 34-39)

Regarding claim 48, one in the art would appreciate that the veneer layers could be pressed into the substrate less than their thickness when it was desired to have a raised pattern present. It would have been obvious to one of ordinary skill in the art at the time the invention was made to press the veneer layers into the substrate less than their thickness since this would leave a raised pattern, a decorative touch often desired in the woodworking arts.

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Regarding claim 49, Hartzell discloses multiple pieces are pressed into the substrate and these pieces contrast with the substrate.(Pg. 1, ll. 60-65) One in the art reading the reference as a whole would appreciate that different kinds of wood could be used in the veneering to form designs with different colors and different grain patterns and would do so for that reason.

Regarding claim 50, embossing is a well-known technique in the decorative arts for adding detail to a design by creating raised and depressed areas in a layer to create texture and detail. It would have been obvious to one of ordinary skill in the art at the time the invention was made to emboss the veneer pieces of Hartzell and Rettenbacher et al. to create texture and detail in the final design as is known in the decorative arts.

Regarding claims 52 and 53, Rettenbacher et al. discloses the substrate can contain wood fibers.(Col. 3, ll. 31-34)

7. Claims 34-36 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartzell, Rettenbacher et al, and Jaschke et al. as applied to claims 26 and 43 above, and further in view of Valle(DE 3012910A1).

The references cited above do not disclose a fabric layer between the veneer and the substrate. Valle discloses using fabric layers in substrates under veneer layers to reinforce the product.(Abstract) It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a fabric layer between the veneer and substrate of Hartzell, Rettenbacher et al., and Jaschke et al. since this would reinforce the product making it more difficult to destroy.(Abstract)

Regarding claim 36, Valle discloses the fabric can be jute. One in the art would appreciate that other natural plants fibers could also be used. Only the expected results would be achieved.

8. Claims 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartzell, Rettenbacher et al., and Jaschke et al. as applied to claim 26 above, and further in view of Ogata et al.(U.S. Patent 4,911,969).

The references cited above do not disclose what the formed article is used for. The uses of products having veneer as an outer surface is well-known in the wood-working arts as shown for example by Ogata et al. which discloses a product with a wood pattern surface which can be used as flooring or wall materials or furniture.(Col. 1, ll. 6-12) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the product of Hartzell, Rettenbacher et al., and Jaschke et al. for any of the well-known uses of such decorative articles as shown for example by Ogata et al.(Col. 1, ll. 6-12)

#### ***Allowable Subject Matter***

9. Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 28 and 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.



11. The following is a statement of reasons for the indication of allowable subject matter: regarding claims 28 and 29, the prior art of record does not teach or fairly suggest a substrate consisting essentially of a natural polymer having minor amounts of a synthetic thermoplastic polymer. Regarding claim 33, the prior art of record does not teach or fairly suggest overlapping decorative fabric layers which are embedded in a polymer.

#### ***Information Disclosure Statement***

12. The information disclosure statement filed 7/11/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the references not present in the application have not been considered.

#### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Barbara J. Musser** whose telephone number is **(703)-305-1352**. The examiner can normally be reached on Monday-Thursday; alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
BJM  
August 28, 2003

  
Michael W. Ball  
Supervisory Patent Examiner  
Technology Center 1700